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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,207	01/17/2001	Ansgar Brock	P0021US00	5731
29490	7590	12/06/2004	EXAMINER	
GENOMICS INSTITUTE OF THE NOVARTIS RESEARCH FOUNDATION 10675 JOHN JAY HOPKINS DRIVE, SUITE E225 SAN DIEGO, CA 92121-1127			NOLAND, THOMAS	
			ART UNIT	PAPER NUMBER
			2856	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/765,207		BROCK ET AL.	
	Examiner		Art Unit	
	Thomas P. Noland		2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-72 and 74-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-72, 74-76 and 78-81 is/are rejected.
- 7) ☒ Claim(s) 77 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03122004</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Prosecution on the merits of this application is reopened on claims 68-72, 74-76 and 78-81 considered unpatentable for the reasons indicated below:

These claims are considered unpatentable in view of the newly discovered reference(s) to O'Connor et al US 2002/0003177 cited in the not heretofore considered IDS filed March 12, 2004 without a certification under 37 CFR 1.97(e) and after the first action on the merits. Rejections based on the newly cited reference(s) follow. The delay in consideration of the IDS is regretted.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 68-70, 72, 74-75 and 78-80 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Connor et al.

Note O'Connor et al's provisional application 60/197,010 filed March 17, 2000 supports the disclosure of O'Connor et al US 2002/0003177.

In O'Connor et al Fig. 4A shows a structure like that of claims 68-69 and 79. (Note claim 79 was amended by examiner's amendment). The abstract indicates that the sample plate could be charged as one alternative. Paragraph 65 indicates that the

droplet can be grounded. Paragraphs 56-58 suggest that such features can be applied to the multi-capillary embodiments illustrated in Figs 4A-5D.

Re claims 70 and 72 Fig. 5A shows that the sample plate holder is movable.

Re claims 74-75, 78 and 80 these features would be inherent from the application of the teachings of paragraphs 56-58 to electrically charge or ground the selected element. Element 62 in Fig. 4 is an electrode plate. The use of a controller is directly specified in paragraphs 57-58.

4. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al.

O'Connor et al uses a conveyor belt instead of a motion table to move sample plate holders. But the use of such a means to move sample handlers in analyzing systems is a known expedient and would have been obvious to use when convenient in view of the teaching in paragraph 58 that alternative positioning means could be used.

5. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al in view of Morozova et al, cited as Ref. C21 in IDS of June 21, 2002.

O'Connor does not specifically disclose having electrical connections between the power supply and each capillary but the usefulness of such an arrangement to provide greater control would have been readily apparent to one of ordinary skill in view of the illustration of such an arrangement in the similar arrangement shown in Figs 1A

and 1B on page 3111 of Morozova et al. Note claim 76 was amended by examiner's amendment.

6. Claim 81 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al in view of Sauter et al US 6,149,815, previously cited.

O'Connor et al does not disclose the connection of the capillary to a liquid chromatograph column but such would have been an obvious expedient to aid analysis and in view of the teaching of the ease of use of a similar deposition system with liquid chromatography in col. 1, lines 64-67 of Sauter et al.

7. Claim 77 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on March 12, 2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

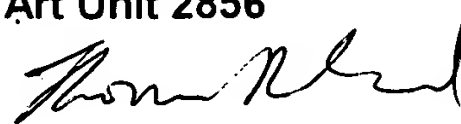
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Noland whose telephone number is (571) 272-2202. The examiner can normally be reached on weekdays from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hezron E. Williams, can be reached on (571) 272-2208.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Thomas P. Noland
Primary Examiner
Art Unit 2856



tpn
Nov. 4, 2004